

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1, 3, 4, 6, 7, 10, 13 and 14 are rejected under 35 U.S.C. 102(b) over the German patent document DE 644011.

Also, the drawings were objected to and the claims were rejected under 35 U.S.C. 112.

In connection with the Examiner's questions related to the turnable auxiliary handle and the turnable outlet pipe, applicants amended the specification substantially in compliance with the Examiner's statement, by defining that the turnability of the auxiliary handle and of the outlet pipe can be implemented by a conventional structure. As for the Examiner's objections to the transverse location of said auxiliary handle with respect to the first handle, it was respectfully requested that this particular feature was shown in the drawings, for example in Figure 2. Since the drawings constitute a part of the original disclosure, it is believed that it is acceptable to define this feature in the independent claims. At the same time the Examiner's grounds for the objections and rejections are completely justified, and in connection with this, applicants have amended the specification to define that the auxiliary handle extends in a plane

which is transverse to the first handle in compliance with the language of the claims and the showing in the drawings.

It is believed that the Examiner's grounds for the objection to the drawings and rejection of the claims should be withdrawn. Applicants herewith submit a copy of the drawings with explanations related to the issues raised by the Examiner for purely information, exclusively for information purposes.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicants amended claim 1 by incorporating into it a part of claim 3, that the air further flows into the inlet of the auxiliary handle. The corresponding part of claim 3 has been canceled.

The same insert has been made in claim 14, which is the second independent claim.

It is first of all respectfully submitted that the changes in claims 1 and 14 did not raise any issues for the examination or search, because these changes came from claim 3 which is dependent on claim 1 and was examined by the Examiner before the Final Action.

It is respectfully submitted that claims 1 and 14 clearly and patentably distinguish the present invention from the prior art applied by the Examiner.

Turning now to the references and in particular to the German patent to Sauer, it can be seen that this reference discloses a groove milling tool.

As can be seen from the construction of the tool disclosed in this reference, the handle of the tool in the patent to Sauer does not carry dust-air/debris. The handle disclosed in this reference carries only motor spent air. Debris is to be sucked in at 13 over a nozzle and over saw-blade 11 to enter appendix 13 of the handle 16. The energy of the air-stream becomes low after having gone through the handle 16 arriving at appendix 13. It may take away only some of the removed material.

The handle of the tool disclosed in the patent to Sauer communicates with the whole appendix 13 not over an inlet, but instead over an outlet. The outlet 14 is completely different from the inlet 22 in the present application for taking the motor-cooling air together with the debris, accelerated by the saw blade. When as in the applicant's invention the motor cooling air which has left the motor housing before, then enters and passes the protective hood, and then enters the inlet 22 of

the auxiliary handle 21 and passes through the handle 21, the noise of three sources is diminished, namely the one of the motor, the one of the motor cooling fan, and the one of the saw blade are damped and diminished within the handle 21.

It should be further emphasized that the auxiliary handle 16 of the patent to Sauer does not extend toward an inlet, but instead it is getting much tighter than meeting the saw blade 11 and making a nozzle there, in contrast to the applicant's invention in which their passage extends toward the inlet of the auxiliary handle.

When the tool is designed in accordance with the present invention, in contrast to the construction disclosed in the patent to Sauer, the motor spent air is completely separated from the saw blade and it meets the stream of the removed material only in the inlet pipe 22 of the auxiliary handle. The handle in accordance with the present invention transports the dust and the cooling air making a wide bow and making it easy for the dust/air to be carried away from its offspring and to be blown out without jamming anywhere not at the inlet 22 and not within the handle 21. With this particular solution, all three kinds of noise are diminished tremendously.

An additional difference is that in the Sauer device the length of the pipe for transporting the motor spent air together with the removed material is very short, happening only in the appendix 13, so that the noise of the saw blade is not diminished.

In contrast, in accordance with the present invention, in the handle the air has time to expand, to relax, and this way to diminish the noise of the saw blade.

It is therefore believed to be clear that the new features of the present invention as defined in claims 1 and 14 are not disclosed in the reference, and also can not be derived from it as a matter of obviousness. Original claims were rejected as being anticipated. In connection with this, it is believed to be advisable to cite the decision in re Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the reference does not disclose each and every feature of the present invention which is now defined in the independent claims.

While the Examiner did not reject the claims as obvious, it is believed that the obviousness rejection should also be considered as not applicable with respect to the independent claims. In order to arrive at the applicant's invention from the reference, the reference has to be fundamentally modified, in particular by including into it the features which were first proposed by the applicants. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Finally, as explained herein above, the present invention provides for the highly advantageous results which can not be accomplished by the construction disclosed in the reference. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case Ex parte Tanaka, Marushima and Takahashi (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that claims 1 and 14 should be allowed, together with other claims which depend on claim 1, and share its presumably allowable features.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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